



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/155,327 03/29/99 CORY

S 11686

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HM22/1010

EXAMINER

KAUSHAL, S

ART UNIT

PAPER NUMBER

1633

DATE MAILED:

10/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Advisory Action**

Application No.

09/155,327

Applicant(s)

CORY ET AL.

Examiner

Sumesh Kaushal Ph.D.

Art Unit

1633

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 August 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☒ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-4.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other:

Continuation of 2. NOTE: The amendment of SEQ ID NO: 6-9 raises the issues of new matter. Even if the amendments of SEQ ID NO: 6-9 were entered, it would require further search and consideration under 35 USC 102 regarding prior art issues.

Continuation of 5. does NOT place the application in condition for allowance because: The amendment of SEQ ID NO: 6-9 was not entered. Therefore the pending claims 1-4 stand rejected for the same reason of record as set forth in the office action mailed on 4/9/01.

Claims 1-4 stand rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated nucleic acid consisting of SEQ ID NO: 6 and 8 encoding the amino acid sequences of SEQ ID NO: 7 and 9, does not reasonably provide enablement for an isolated nucleic acid comprising any and all derivatives of SEQ ID NO: 6 and 8, which has 47% or greater similarities to the amino acid sequence of SEQ ID NO: 7 and 9, or derivatives thereof and wherein the protein enhances cell survival. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims, for the same reasons of record as set forth in the official action mailed on 04/09/01.

The applicant argues that the present specification adequately teaches the molecules as claimed including derivatives and homologs of SEQ ID NO: 6 and 8. The applicant further argues that in the light of present teaching those skilled in the art can isolate a nucleic acid that either hybridizes to SEQ ID NO: 6 or 8 or encodes a protein that share at least about 47% similarity to SEQ ID NO: 7 or 9. The applicant further argues that claims 1-4 are canceled rendering the rejection moot. However, this is found unpersuasive because the newly filed claims 21-24 are not entered for the reason as set forth in section 2 of advisory action (page-1). In addition, claims 1-4 stand rejected because the specification fails to disclose any and all variants of SEQ ID NO: 6 and 8, which has 47% or greater similarities to the amino acid sequence of SEQ ID NO: 7 and 9.

Claims 1 and 4 stand rejected under 35 U.S.C. 102(e) as being anticipated by Guastella (US 5,789,201 07/04/1998, of record). Guastella teaches nucleotide sequences encoding a bcl-2 homolog (bcl-y) which matches 97.4% to SEQ ID NO: 6, 98.7% to SEQ ID NO: 7, 85.65 to SEQ ID NO: 8 and 96.9% to SEQ ID NO: 9 (see PTO sequence search report).

The applicant argues that cancellation of claims 1-4 in view of claims 21-24 renders the rejection moot. However, this is not found persuasive because the newly filed claims 21-24 are not entered for the reason as set forth in section 2 of advisory action (page-1).

*Scott D. Priebe*

SCOTT D. PRIEBE, PH.D  
PRIMARY EXAMINER